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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/410,162	09/30/99	KLOSOWSKI J	DC4810

IM22/1006

ROBERT L MCKELLAR
DOW CORNING CORPORATION
PATENT DEPARTMENT MAIL C01232
MIDLAND MI 48686-0994

EXAMINER	
CAMERON, E	
ART UNIT	**PAPER NUMBER**
1762	5

DATE MAILED: 10/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/410,162	Klosowski et al
Examiner	**Group Art Unit**
Erma Cameron	1762

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *51-71* is/are pending in the applicat

Of the above, claim(s) *52, 53, and 56-71* is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *51, 54, and 55* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

a species selection among siloxanes with silanol groups, siloxanes with SI-H bonds and siloxanes with unsaturated groups; silanes with oximo, acetoxy or alkoxy groups; the presence or absence of a catalyst; combinations of siloxanes and silanes.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Robert McKellar on September 25, 2000 a provisional election was made with traverse to prosecute the invention of preserving with acetoxy silanes, claims 51, 54 and 55. Affirmation of this election must be made by applicant in replying to this Office action. Claims 52-53 and 56-71 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 112

4. Claims 51 and 54 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claim 51: it is not clear what is meant by the product of (I). In what way is the impregnating step creating a product?

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 51, 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinchuk (5736251).

'251 teaches forming a coating on an elastomeric article (i.e. organic) with a silane such as methyltriacetoxysilane (5:64) that is cured into a homopolymer or copolymer (6:6-19).

'251 fails to teach that the coating preserves the substrate, but such an effect would be inherent to the silanes used.

7. Claims 51, 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leidheiser et al.

Leidheiser teaches the protection of an inorganic material such as steel panels with polymerized methyltriacetoxy silane (see Abstract).

Leidheiser fails to teach that the coating preserves the substrate, but protection against corrosion is a type of preservation.

Priority

8. This application filed under former 37 CFR 1.62 lacks the necessary reference to the prior application. A statement reading "This is a divisional of Application No. 09/129296, filed August 5, 1998, now U.S. Patent No. 6022589, which is a continuation-in-part of Application No. 08/780508, filed January 8, 1997, now abandoned." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of the parent nonprovisional application(s) should be included.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is (703) 308-2330.

Erma Cameron

ERMA CAMERON
PATENT EXAMINER
GROUP 1100

Erma Cameron

September 29, 2000